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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/910,859

07/24/2001

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6806/3

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11/23/2007

EXAMINER

MONFELDT, SARAH M

ART UNIT

PAPER NUMBER

3692

MAIL DATE

DELIVERY MODE

11/23/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 09/910,859	Applicant(s) CHODES, GARY	
	Examiner Sarah M. Monfeldt	Art Unit 3692	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 September 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-32, 34 and 35 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-32, 34 and 35 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION
Status of Claims

1. This action is in reply to the Amendment/Response filed on 24 September 2007.
2. Claims 1, 2, 11, 13-17, 19, 26-31, 34-35 have been amended.
3. Claim 33 has been canceled.
4. Claims 1-32, 34-35 are currently pending and have been examined.

New Examiner

5. Please note that this application has been assigned to a new Examiner, Sarah M. Monfeldt.
6. After review of the prosecution history for the present application, including the Declaration 131 submitted on 25 July 2006 and the Declaration 131 submitted on 7 March 2007, the Examiner has noted that these declarations contain deficiencies and are insufficient to overcome the Richman et al. (US 6,625,582) reference, the declarations will be discussed below. The Examiner apologizes for any inconvenience this may cause and invites Applicants to contact the Examiner directly with any questions at (571)270-1833.

37 CFR 1.131 Declarations

7. The declarations filed on 25 July 2006 and 7 March 2007 under 37 CFR 1.131 have been considered but are ineffective to overcome the cited reference because the scope of the declarations are not commensurate with the scope of the claim(s). Furthermore, the declarations are not accompanied by evidence commensurate with the scope of the claim(s) to establish diligence from a date prior to the date of reduction to practice of the cited reference to either a constructive reduction to practice or an actual reduction to practice. Moreover, when the claims of the reference U.S. patent or U.S. patent application publication and the application are directed to the same invention or are obvious variants, an affidavit or declaration under 37 CFR 1.131 is not an acceptable method of overcoming the rejection.

Evidence/Diligence

8. The evidence submitted is insufficient to establish diligence from a date prior to the date of reduction to practice of the cited reference to either a constructive reduction to practice or an actual reduction to practice.

9. An applicant must account for the entire period during which diligence is required. *Gould v. Schawlow*, 363 F.2d 908, 919, 150 USPQ 634, 643 (CCPA 1966) (Merely stating that there were no weeks or months that the invention was not worked on is not enough.); *In re Harry*, 333 F.2d 920, 923, 142 USPQ 164, 166 (CCPA 1964) (statement that the subject matter "was diligently reduced to practice" is not a showing but a mere pleading). A 2-day period lacking activity has been held to be fatal. *In re Mulder*, 716 F.2d 1542, 1545, 219 USPQ 189, 193 (Fed. Cir. 1983) (37 CFR 1.131 issue); *Fitzgerald v. Arbib*, 268 F.2d 763, 766, 122 USPQ 530, 532 (CCPA 1959) (Less than 1 month of inactivity during critical period. Efforts to exploit an invention commercially do not constitute diligence in reducing it to practice. An actual reduction to practice in the case of a design for a three-dimensional article requires that it should be embodied in some structure other than a mere drawing.); *Kendall v. Searles*, 173 F.2d 986, 993, 81 USPQ 363, 369 (CCPA 1949) (Diligence requires that applicants must be specific as to dates and facts.).

10. The period during which diligence is required must be accounted for by either affirmative acts or acceptable excuses. *Rebstock v. Flouret*, 191 USPQ 342, 345 (Bd. Pat. Inter. 1975); *Rieser v. Williams*, 225 F.2d 419, 423, 118 USPQ 96, 100 (CCPA 1958) (Being last to reduce to practice, party cannot prevail unless he has shown that he was first to conceive and that he exercised reasonable diligence during the critical period from just prior to opponent's entry into the field); *Griffith v. Kanamaru*, 816 F.2d 624, 2 USPQ2d 1361 (Fed. Cir. 1987) (Court generally reviewed cases on excuses for inactivity including vacation extended by ill health and daily job demands, and held lack of university funding and personnel are not acceptable excuses.); *Litchfield v. Eigen*, 535 F.2d 72, 190 USPQ 113 (CCPA 1976) (budgetary limits and availability of animals for testing not sufficiently described); *Morway v. Bondi*, 203 F.2d 741, 749, 97 USPQ 318, 323 (CCPA 1953) (voluntarily laying aside inventive concept in pursuit of other projects is generally not an acceptable excuse although there may be circumstances creating exceptions); *Anderson v. Crowther*, 152 USPQ 504, 512 (Bd. Pat. Inter. 1965) (preparation of routine periodic reports covering all accomplishments of the laboratory insufficient to show diligence); *Wu v. Jucker*, 167 USPQ 467, 472-73 (Bd. Pat. Inter. 1968) (applicant improperly allowed test data sheets to accumulate to a sufficient amount to justify interfering with equipment then in use on another project); *Tucker v. Natta*, 171 USPQ 494, 498 (Bd. Pat. Inter. 1971) ("[a]ctivity directed toward the reduction to practice of a genus does not establish, prima facie, diligence toward the reduction to practice of a species embraced by said genus"); *Justus v. Appenzeller*, 177 USPQ 332, 340-1 (Bd. Pat. Inter. 1971) (Although it is possible that patentee could have reduced the invention to practice in a shorter time by relying on stock items rather than by designing a particular piece of hardware, patentee exercised reasonable diligence to secure the required hardware to actually reduce the invention to practice. "[I]n deciding the question of diligence it is immaterial that the inventor may not have taken the expeditious course..").
11. Furthermore, evidence drawn towards work on improvement of samples or specimens generally already in use at the time of conception that are but one element of the oscillator circuit of the count does not show diligence towards the construction and testing of the overall combination.); *Broos v. Barton*, 142 F.2d 690, 691, 61 USPQ 447, 448 (CCPA 1944) (preparation of application in U.S. for foreign filing constitutes diligence); *De Solms v. Schoenwald*, 15 USPQ2d 1507 (Bd. Pat. App. & Inter. 1990) (principles of diligence must be given to inventor's circumstances including skill and time; requirement of corroboration applies only to testimony of inventor); *Huelster v. Reiter*, 168 F.2d 542, 78 USPQ 82 (CCPA 1948) (if inventor was not able to make an actual reduction to practice of the invention, he must also show why he was not able to constructively reduce the invention to practice by the filing of an application).

12. The diligence of attorney in preparing and filing patent application inures to the benefit of the inventor. Conception was established at least as early as the date a draft of a patent application was finished by a patent attorney on behalf of the inventor. Conception is less a matter of signature than it is one of disclosure. Attorney does not prepare a patent application on behalf of particular named persons, but on behalf of the true inventive entity. Six days to execute and file application is acceptable. *Haskell v. Coleburne*, 671 F.2d 1362, 213 USPQ 192, 195 (CCPA 1982). See also *Bey v. Kollonitsch*, 866 F.2d 1024, 231 USPQ 967 (Fed. Cir. 1986) (Reasonable diligence is all that is required of the attorney. Reasonable diligence is established if attorney worked reasonably hard on the application during the continuous critical period. If the attorney has a reasonable backlog of unrelated cases which he takes up in chronological order and carries out expeditiously, that is sufficient. Work on a related case(s) that contributed substantially to the ultimate preparation of an application can be credited as diligence.).
13. In this case, applicant's Exhibits A and B attached to 25 July 2006 declaration are memorandums indicating conception of at least the first claim and thus do not show a reduction to practice for the entire claimed invention. Also the 7 March 2007 declaration states "the following is a declaration demonstrating that work was done diligently to perfect the invention set out and as claimed in the above-identified application" is incomplete since no evidence has been presented and thus the 7 March 2007 does not establish diligence accompanied by evidence to overcome the *Richman et al.* (US 6,625,58) reference.

Same Invention

14. Furthermore, when the claims of the reference U.S. patent or U.S. patent application publication and the application are directed to the same invention or are obvious variants, an affidavit or declaration under 37 CFR 1.131 is not an acceptable method of overcoming the rejection.
15. The *Richman et al.* (US 6,625,58) reference is a U.S. patent or U.S. patent application publication of a pending or patented application that claims the rejected invention. An affidavit or declaration is inappropriate under 37 CFR 1.131(a) when the reference is claiming the same patentable invention, see MPEP § 2306. If the reference and this application are not commonly owned, the reference can only be overcome by establishing priority of invention through interference proceedings. See MPEP Chapter 2300 for information on initiating interference proceedings. If the reference and this application are commonly owned, the reference may be disqualified as prior art by an affidavit or declaration under 37 CFR 1.130. See MPEP § 718.

Specification

16. Claims 22-23 are objected to because of the following informalities: Claims 22-23 do not find antecedent basis in the specification as filed, in particular, the use of the term "debtor". Appropriate correction is required.

Claim Rejections - 35 USC § 112

17. The following is a quotation of the second paragraph of 35 U.S.C. 112:
The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
18. Claims 1-30 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Vague & Indefinite:

(1) Claims 22-23 recite the term "debtor". It is not clear as to what the claims are attempting to encompass since the definition of debtor is "one who owes another something or is under obligation to pay money or to fulfill some other obligation", please refer to the attached the definition of debtor from the Dictionary of Business Terms. In particular, it is not clear as to why an advance payment or loan would be paid to a debtor based on the definition of debtor and especially since the second account contains the money of the retiree participant swept from the first account. Is the debtor the retiree participant who has debt to pay, or is the debtor the provider of the loan paying down another debt? Appropriate clarification and correction is required.

Relative Terminology:

(1) The terms "early", "normal", and "delayed" in claim 9 are relative terms which renders the claim indefinite. The term terms "early", "normal", and "delayed" are not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention. Furthermore, as time progresses the age at which one can collect social security and other retirement benefits changes. Moreover, as the rules and regulations change there are different age brackets indicating when a person can collect retirement benefits, which are dependent on when those changes to the rules and regulations were made. Appropriate correction is required.

(2) The term "minimum" in claim 13 is a relative term which renders the claim indefinite. The term "minimum" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention. Appropriate correction is required.

Claim Rejections - 35 USC § 102

19. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

20. Claims 1, 12, 16, 19-28, 31-32 and 34 are rejected under 35 U.S.C. 102(e) as being anticipated by Richman et al (hereinafter Richman US PAT 6,625,582 B2).

Examiner's Note: The Examiner has pointed out particular references contained in the prior art of record within the body of this action for the convenience of the Applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply. Applicant, in preparing the response, should consider fully the entire reference as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the Examiner.

Claim 1 –

Richman et al. disclose a *method for providing a retiree participant with a loan in exchange for non-directly assignable benefits received by the participant* having the limitations of:

- *determining a value for the loan for the retiree participant after the retiree participant has retired (see at least Column 1, lines 52-59)*
- *paying the loan to the participant (see at least Column 3, lines 38-45)*
- *directing the received non-directly assignable benefits to a retiree participant account (see at least Column 5, lines 39-41)*
- *periodically transferring the received non-directly assignable benefits from the retiree participant account to a second account (see at least Column 5, lines 49-52).*

Claim 12 –

Richman et al. teaches the method of claim 1 as described above. Richman et al. further discloses a *method for providing a retiree participant with a loan in exchange for non-directly assignable benefits received by the participant* having the limitations of:

- *wherein the non-directly assignable benefits comprise Social Security benefits (see at least Column 1, lines 43-49)*

Claim 16 –

Richman et al. teaches the method of claim 1 as described above. Richman et al. further discloses a *method for providing a retiree participant with a loan in exchange for non-directly assignable benefits received by the participant* having the limitations of:

- *wherein the received non-directly assignable benefits in the retiree participant account are received on a preselected day, and wherein the received non-directly assignable benefits in the retiree participant account are transferred to the second account within a predetermined period following the preselected day. (see at least col. 5, ll. 17-27, 46-53)*

Claim 19 –

Richman et al. teaches the method of claim 1 as described above. Richman et al. further discloses a *method for providing a retiree participant with a loan in exchange for non-directly assignable benefits received by the participant* having the limitations of:

- *wherein the second account is held by a provider of the loan (see at least Column 3, lines 46-50).*

Claim 20 –

Richman et al. teaches the method of claim 1 as described above. Richman et al. further discloses a *method for providing a retiree participant with a loan in exchange for non-directly assignable benefits received by the participant* having the limitations of:

- *wherein the second account is held by an account provider, the method further comprising paying a service fee to the account provider for the second account (see at least Column 3, lines 51-58)*

Claim 21 –

Richman et al. teaches the method of claim 20 as described above. Richman et al. further discloses a *method for providing a retiree participant with a loan in exchange for non-directly assignable benefits received by the participant* having the limitations of:

- *wherein the service fee is paid from the transferred swept benefits (see at least Column 3, lines 51-58).*

Claim 22 –

Richman et al. teaches the method of claim 1 as described above. Richman et al. further discloses a *method for providing a retiree participant with a loan in exchange for non-directly assignable benefits received by the participant* having the limitations of:

- *paying a loan payment to a debtor from the second account. (see at least col. 6, ll. 38-45)*

Claim 23 –

Richman et al. teaches the method of claim 1 as described above. Richman et al. further discloses a *method for providing a retiree participant with a loan in exchange for non-directly assignable benefits received by the participant* having the limitations of:

- *paying an advance payment to a debtor from the second account. (see at least col. 6, ll. 38-45)*

Claim 24 –

Richman et al. teaches the method of claim 1 as described above. Richman et al. further discloses a *method for providing a retiree participant with a loan in exchange for non-directly assignable benefits received by the participant* having the limitations of:

- *paying a fee to at least one service provider from the second account. (see at least col. 5, ll. 53-65)*

Claim 25 –

Richman et al. teaches the method of claim 24 as described above. Richman et al. further discloses *a method for providing a retiree participant with a loan in exchange for non-directly assignable benefits received by the participant* having the limitations of:

- wherein the at least one service provider is one selected from a group consisting of a financial planner, a financial advisor, an estate planner, an insurance agent, an insurance advisor, a lawyer, a certified public accountant, and a broker. (see at least col. 3, ll. 20-22)

Claim 26 –

Richman et al. teaches the method of claim 24 as described above. Richman et al. further discloses *a method for providing a retiree participant with a loan in exchange for non-directly assignable benefits received by the participant* having the limitations of:

- wherein the at least one service provider is a provider of the loan. (see at least col. 3, ll. 38-40)

Claim 27 –

Richman et al. teaches the method of claim 1 as described above. Richman et al. further discloses *a method for providing a retiree participant with a loan in exchange for non-directly assignable benefits received by the participant* having the limitations of:

- wherein the loan comprises one selected from a group consisting of recourse loan proceeds, limited recourse loan proceeds, and non-recourse loan proceeds. (see at least col. 6, ll. 20-24)

Claim 28 –

Richman et al. teaches the method of claim 1 as described above. Richman et al. further discloses *a method for providing a retiree participant with a loan in exchange for non-directly assignable benefits received by the participant* having the limitations of:

- wherein the loan is a non-recourse advance. (see at least col. 6, ll. 20-24)

Claim 31 –

Richman et al. disclose *a method for providing a method for a provider to provide a loan to a retiree participant in exchange for Social Security benefits* having the limitations of:

- determining a value for the loan after the retiree participant has retired (Column 3, lines 38-46)
- paying the loan to the retiree participant (see at least Fig 2, see at least Column 3, lines 38-45)
- the retiree participant opening a new account (see at least Column 5, lines 39-42)
- the retiree participant providing instructions to direct the Social Security benefits to the new account (see at least Column 5, lines 49-52); and

- *periodically transferring the directed benefits from the new account to a second account, (see at least Column 5, lines 46-59)*
- *wherein the second account is held by the provider (see at least Column 5, lines 46-59).*

Claim 32 –

Richman et al. teaches the method of claim 31 as described above. Richman et al. further discloses *a method for providing a retiree participant with a loan in exchange for non-directly assignable benefits received by the participant having the limitations of:*

- *wherein the loan is one selected from a group consisting of a nonrecourse loan, a recourse loan, and a limited recourse loan. (see at least col. 6, ll. 20-24)*

Claim 34 –

Richman et al. disclose *a method for providing a system for providing a retiree participant with a loan in exchange for non-directly assignable benefits received by the retiree participant having the limitations of:*

- *means for determining a value for the loan for the retiree participant after the retiree participant has retired (see at least Column 3, lines 38-46)*
- *means for paying the loan to the retiree participant (see at least Fig 2, Ref 32)*
- *means for directing the received non-directionally assignable benefits to a retiree participant account (see at least Column 5, lines 39-42)*
- *means for periodically transferring the received non-directly assignable benefits from the retiree participant account to a second account (see at least Column 5, lines 46-59).*

Claim Rejections - 35 USC § 103

21. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

22. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

23. Claims 2-4, 8-9, 29-30, 35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Richman et al., as applied to claims 1, 12, 16, 19-28, 31-32 and 34, above further in view of Livingston (US 2001/0047325).

Claim 2 –

Richman et al. teaches the method of claim 1 as described above. Richman et al. do not explicitly disclose:

- *wherein determining a value for the loan for the retiree participant includes: inputting participant specific data; inputting criteria for return goals; and analyzing the input participant specific data and the criteria for return goals.*

Livingston teach *wherein determining a value for the loan for the retiree participant includes: inputting participant specific data; inputting criteria for return goals; and analyzing the input participant specific data and the criteria for return goals* (see at least paragraph [0005]). It would have been obvious to one of ordinary skill in the art at the time of the invention to expand the method of Richman et al. to include estimating life expectancy as taught by Livingston. One of ordinary skill in the art at the time of the invention would have been motivated to expand the method of Richman et al. in this way since this allows for seniors to utilize collateral in their life insurance for a non-recourse line of credit with an established top limit borrowing amount (see at least paragraph [0006] of Livingston).

Claim 3 –

Richman et al. in view of Livingston teaches the method of claim 2 as described above.

Livingston, at least at paragraph [0031], further discloses *a method for providing a retiree participant with a loan in exchange for non-directly assignable benefits received by the participant having the limitations of:*

- *wherein the participant specific data includes at least one selected form a group consisting of age, health, life expectancy information, credit, and financial information.*

The motivation for making this modification to the teachings of Richman et al. is the same as that set forth above, in the rejection of Claim 2.

Claim 4 –

Richman et al. in view of Livingston teaches the method of claim 2 as described above. Richman et al., at least at *Column 1, lines 43-49*, further discloses a *method for providing a retiree participant with a loan in exchange for non-directly assignable benefits received by the participant* having the limitations of:

- *wherein the participant specific data includes at least one selected from a group consisting of earnings history, expected future earnings, and social securing benefit information.*

Claim 8 –

Richman et al. in view of Livingston teaches the method of claim 2 as described above. Richman et al., at least at *Column 1, lines 52-67*, further discloses a *method for providing a retiree participant with a loan in exchange for non-directly assignable benefits received by the participant* having the limitations of:

- *wherein the participant specific data includes retirement information.*

Claim 9 –

Richman et al. in view of Livingston teaches the method of claim 8 as described above. Richman et al., at least at *Column 1, lines 52-67*, further discloses a *method for providing a retiree participant with a loan in exchange for non-directly assignable benefits received by the participant* having the limitations of:

- *wherein the retirement information includes information relating to one selected from a group consisting of early retirement, normal retirement, and delayed retirement.*

Claim 29 –

Richman et al. in view of Livingston teaches the method of claim 1 as described above. Richman et al. do not explicitly disclose:

- *determining whether to approve payment of the loan to the retiree participant.*

Livingston teach *determining whether to approve payment of the loan to the retiree participant* (see at least paragraph [0021]-[0022]). It would have been obvious to one of ordinary skill in the art at the time of the invention to expand the method of Richman et al. to include loan determination as taught by Livingston. One of ordinary skill in the art at the time of the invention would have been motivated to expand the method of Richman et al. in this way since proper determination of originating loans borrowers (see at least paragraph [0010] of Livingston).

Claim 30 –

Richman et al. in view of Livingston teaches the method of claim 29 as described above. Livingston, at least at paragraph [0022], further discloses *a method for providing a retiree participant with a loan in exchange for non-directly assignable benefits received by the participant having the limitations of:*

- *further comprising if a determination is made to approve payment of the loan to the retiree participant, transmitting approval information to the retiree participant.*

The motivation for making this modification to the teachings of Richman et al. is the same as that set forth above, in the rejection of Claim 29.

Claim 35 –

Richman et al. disclose *a system for providing a participant with a loan in exchange for non-directly assignable benefits received by the retiree participant having the limitations of:*

- *a loan processing server couple to a network, the loan processing server for receiving an analyzing data (see at least Fig 1, 20);*
- *a financial institution server coupled to the network (see at least Fig 1, 20, 22)*
- *wherein the loan processing server receives loan determination data for the retiree participant, the loan determination data including non-directly assignable benefits information; (see at least col. 3, ll. 28-50)*
- *wherein the loan processing server determines a value for the loan after the retiree participant has retired; (see at least col. 3, ll. 28-50)*
- *wherein the loan value information is transmitted to the financial institution server; (see at least col. 3, ll. 28-50)*
- *wherein payment of the loan is made to the retiree participant (see at least col. 3, ll. 34-38)*

Richman does not explicitly disclose:

- *an underwriting server coupled to the network;*
- *wherein the loan processing server transmits the loan determination data to the underwriting server;*
- *wherein the underwriting server transmits the risk information to the loan processing server.*

Livingston teach *an underwriting server coupled to the network; wherein the loan processing server transmits the loan determination data to the underwriting server; wherein the underwriting server transmits the risk information to the loan processing server (see at least Fig. 1, paragraphs [0011]-[0023])*

It would have been obvious to one of ordinary skill in the art at the time of the invention to expand the system of Richman et al. to include loan origination process as taught by Livingston. One of ordinary skill in the art at the time of the invention would have been motivated to expand the system of Richman et al. in this way since Richman teaches a lump sum in an amount or having a value at least in part based upon present value of a designated portion of future retirement payments (determined upon actuarial and other information and utilizing known techniques for calculating present value of a future asset) (see col. 3, ll. 9-46), and Livingston teaches that eligibility is established by underwriting the borrower's medical condition and certain collateral aspects of the pertinent life insurance policy (see at least paragraph [0030] of Livingston).

24. Claims 5-7, 10-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Richman et al., as applied to claims 1, 12, 16, 19-28, 31-32 and 34 above, further in view of Livingston, as applied to claims 2-4, 8-9, 29-30, 35 above, further in view of Jones et al. (US 5239462).

Claim 5 –

Richman et al. in view of Livingston teaches the method of claim 2 as described above. Richman et al. in view of Livingston do not explicitly disclose:

- *wherein the participant specific data includes marital status information for the non-directionally assignable benefits.*

Jones teach *wherein the participant specific data includes marital status information for the non-directionally assignable benefits* (see at least col. 8, ll. 63-68). It would have been obvious to one of ordinary skill in the art at the time of the invention to expand the method of Richman et al. in view of Livingston to include the spouse's SS number and annual household income as taught by Jones. One of ordinary skill in the art at the time of the invention would have been motivated to expand the method of Richman et al. in view of Livingston in this way since this allows the sales person to have more accurate information when determining whether to provide the potential borrower with a loan (see at least col. 8, l. 60 through col. 9, l. 3 of Jones).

Claim 6 –

Richman et al. in view of Livingston teaches the method of claim 2 as described above. Richman et al. in view of Livingston do not explicitly disclose:

- *wherein the participant specific data includes spousal non-directly assignable benefits.*

Jones teach *wherein the participant specific data includes spousal non-directly assignable benefits* (see at least col. 8, ll. 63-68). It would have been obvious to one of ordinary skill in the art at the time of the

invention to expand the method of Richman et al. in view of Livingston to include the spouse's SS number as taught by Jones. One of ordinary skill in the art at the time of the invention would have been motivated to expand the method of Richman et al. in view of Livingston in this way since this allows the sales person to have more accurate information when determining whether to provide the potential borrower with a loan (see at least col. 8, l. 60 through col. 9, l. 3 of Jones).

Claim 7 –

Richman et al. in view of Livingston, further in view of Jones teach the method of claim 6 as described above. Jones, at least at col. 8, ll. 60-68, further disclose:

- *wherein the spousal non-directly assignable benefits information includes one selected from a group consisting of a widow benefits information and spousal social security benefits information.*

The motivation for making this modification to the teachings of Richman et al. in view of Livingston is the same as that set forth above, in the rejection of Claim 6.

Claim 10 –

Richman et al. in view of Livingston teach the method of claim 2 as described above. Livingston, at least at paragraph [0031], further disclose:

- *wherein the criteria data for return goals includes at least one selected from a group consisting of target rate of return, overhead and direct cost assumptions, borrowing costs and leverage, reinsurance or credit loss experience, fraud loss experience, and mortality loss experience.*

The motivation for making this modification to the teachings of Richman et al. is the same as that set forth above, in the rejection of Claim 2.

Claim 11 –

Richman et al. in view of Livingston teach the method of claim 2 as described above. Livingston, at least at paragraph [0023], further disclose:

- *wherein the input participant specific data and the criteria for return goals include at least one selected from a group consisting of total size benefit payments, maturity of loan, assumed interest rate, and effect of cost of living adjustments.*

The motivation for making this modification to the teachings of Richman et al. is the same as that set forth above, in the rejection of Claim 2.

25. Claims 13-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Richman et al., as applied to claims 1, 12, 16, 19-28, 31-32 and 34 above, further in view of Foth et al. (US 6925450).

Claim 13 –

Richman et al. teach the method of claim 1 as described above. Richman et al. do not explicitly disclose:

- *wherein the retiree participant account is a minimum fee account.*

Foth et al. teach *wherein the retiree participant account is a minimum fee account* (see at least col. 5, ll. 26-38; col. 9, ll. 37-42). It would have been obvious to one of ordinary skill in the art at the time of the invention to expand the method of Richman et al. to include interest bearing or non-interest bearing account in which fees can be assessed as taught by Foth et al. One of ordinary skill in the art at the time of the invention would have been motivated to expand the method of Richman et al. in this way since these types of accounts were well known and popular and it therefore would have been obvious to anyone skilled in the ordinary art at the time of invention to adapt the method of Richman to include these teachings so that a participant could utilize an account type that they are familiar with, or simply prefer.

Claim 14 –

Richman et al. teach the method of claim 1 as described above. Richman et al. do not explicitly disclose:

- *wherein the retiree participant account is a non-interest bearing account.*

Foth et al. teach *wherein the retiree participant account is a non-interest bearing account* (see at least col. 5, ll. 26-38; col. 9, ll. 37-42). It would have been obvious to one of ordinary skill in the art at the time of the invention to expand the method of Richman et al. to include a non-interest bearing account as taught by Foth et al. One of ordinary skill in the art at the time of the invention would have been motivated to expand the method of Richman et al. in this way since these types of accounts were well known and popular and it therefore would have been obvious to anyone skilled in the ordinary art at the time of invention to adapt the method of Richman to include these teachings so that a participant could utilize an account type that they are familiar with, or simply prefer.

26. Claims 15, 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Richman et al., as applied to claims 1, 12, 16, 19-28, 31-32 and 34 above, further in view of Petigny (WO 02/45278).

Claim 15 –

Richman et al. teach the method of claim 1 as described above. Richman et al. do not explicitly disclose:

- *wherein the received non-directionally assignable benefits in the retiree participant account are transferred to the second account daily.*

Petigny teach *wherein the received non-directionally assignable benefits in the retiree participant account are transferred to the second account daily* (see at least pg. 6, ll. 6-11). It would have been obvious to one of ordinary skill in the art at the time of the invention to expand the method of Richman et al. to include the period transfer to take place either daily or weekly as taught by Petigny. One of ordinary skill in the art at the time of the invention would have been motivated to expand the method of Richman et al. in this way since Richman et al. disclose that the funds are directed on a regular basis (Column 3, 1lines 46-50), it therefore would have been obvious to anyone skilled in the ordinary art that a regular basis would include daily, weekly, or monthly transfers and even transfers on a preselected day.

Claim 17 –

Richman et al. teach the method of claim 1 as described above. Richman et al. do not explicitly disclose:

- *wherein the received non-directly assignable benefits in the retiree participant account are transferred weekly.*

Petigny teach *wherein the received non-directionally assignable benefits in the retiree participant account are transferred to the second account daily* (see at least pg. 6, ll. 6-11). It would have been obvious to one of ordinary skill in the art at the time of the invention to expand the method of Richman et al. to include the period transfer to take place either daily or weekly as taught by Petigny. One of ordinary skill in the art at the time of the invention would have been motivated to expand the method of Richman et al. in this way since Richman et al. disclose that the funds are directed on a regular basis (Column 3, 1lines 46-50), it therefore would have been obvious to anyone skilled in the ordinary art that a regular basis would include daily, weekly, or monthly transfers and even transfers on a preselected day.

27. Claim 18 is rejected under 35 U.S.C. 103(a) as being unpatentable over Richman et al., as applied to claims 1, 12, 16, 19-28, 31-32 and 34 above, further in view of McCain (US 2002/0004771).

Claim 18 –

Richman et al. teach the method of claim 1 as described above. Richman et al. do not explicitly disclose:

- *wherein the second account is a bankruptcy remote account.*

McCain teach *wherein the second account is a bankruptcy remote account* (see at least paragraph [0088], ll. 10-12). It would have been obvious to one of ordinary skill in the art at the time of the invention to expand the method of Richman et al. to include creditor-proof indemnification trust accounts for the benefit of the employer as taught by McCain. One of ordinary skill in the art at the time of the invention would have been motivated to expand the method of Richman in this way since by creating creditor-proof indemnification trust accounts serves the purpose of indemnifying the employer against the obligations created by the unsecured promise to pay future benefits to employees (see at least paragraph [0088], ll. 12-15 of McCain).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sarah M. Monfeldt whose telephone number is (571)270-1833. The examiner can normally be reached on Monday-Friday 7:30am-5:00pm (EST) ALT Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kambiz Abdi can be reached on (571)272-6702. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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